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10/529,318

03/25/2005

Xavier Blin

05725.1427

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03/17/2010

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EXAMINER

PAK, JOHN D

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Claims 95-101 and 103-216 are pending in this application and they will presently be examined.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 99, 100, 155-158, 216 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For all claim-recited values of Hansen's solubility parameters, e.g. δ_h , δ_p , there is a superscript $\frac{1}{2}$. The interpretation of this superscript is unclear and confusing.

Applicant replied in the response filed on 12/1/2009 that the superscript applied only to the units. This argument has been considered but it still does not provide a full explanation. The units are $(\text{J}/\text{cm}^3)^{1/2}$. Converting J to N-m, which is equal to $(\text{m}^2 \cdot \text{kg}/\text{cm}^3 \cdot \text{sec}^2)$, applicant's claim-recited units can be shown as the square root of $\text{kg}/(\text{m} \cdot \text{sec}^2)$ after cm^3 is converted to m^3 . So this is still confusing because this means the solubility parameter δ_h or δ_p is expressed in terms of square root of $\text{kg}/\text{m} \cdot \text{s}^2$. What is a square root of kg/m per second? What kind of a unit is that for a number? The claims are still confusing.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

Art Unit: 1616

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 95-101, 103-204, and 206-216 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 78-167 of copending Application No. 10/528,699 in view of Marotta et al. (US 6,905,696), HCAPLUS abstract 1964:70247, Flick, and Philippe et al. (US 2002/0064539) for the reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant does not traverse this ground of rejection in the response filed on 12/1/2009. The ground of rejection is maintained. Terminal disclaimer should be timely filed.

Claims 95-101 and 103-216 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 85-184 of copending Application No. 10/528,835 in view of Marotta et al. (US 6,905,696), HCAPLUS abstract 1964:70247, Flick, and Philippe et al. (US 2002/0064539) for the reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant does not traverse this ground of rejection in the response filed on 12/1/2009. The ground of rejection is maintained. Terminal disclaimer should be timely filed.

Claims 100 and 216 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 80-83, 86-87, 90-140 and 142-176 of copending Application No. 10/529,218 in view of Marotta et al., HCAPLUS abstract 1964:70247, Flick, and Philippe et al. for the reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant does not traverse this ground of rejection in the response filed on 12/1/2009. The ground of rejection is maintained. Terminal disclaimer should be timely filed.

Claims 95-101, 103-204 and 206-216 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 77-

80, 83-94, 97-107, 109-161, 165-174 of copending Application No. 10/529,266 in view of Marotta et al. (US 6,905,696), HCAPLUS abstract 1964:70247, Flick, and Philippe et al. (US 2002/0064539) for the reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant does not traverse this ground of rejection in the response filed on 12/1/2009. The ground of rejection is maintained. Terminal disclaimer should be timely filed.

Claims 95-101, 103-204, and 206-216 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 87-189 of copending Application No. 10/529,267 in view of Marotta et al. (US 6,905,696), HCAPLUS abstract 1964:70247, Flick, and Philippe et al. (US 2002/0064539) for the reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant does not traverse this ground of rejection in the response filed on 12/1/2009. The ground of rejection is maintained. Terminal disclaimer should be timely filed.

Claims 95-101, 103-204, and 206-216 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-92 of copending Application No. 10/585,817 in view of Marotta et al. (US 6,905,696),

HCAPLUS abstract 1964:70247, Flick, and Philippe et al. (US 2002/0064539) for the reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant does not traverse this ground of rejection in the response filed on 12/1/2009. The ground of rejection is maintained. Terminal disclaimer should be timely filed.

Claims 95-101, 103-204, and 206-216 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-88 of copending Application No. 10/585,818 in view of Marotta et al. (US 6,905,696), HCAPLUS abstract 1964:70247, Flick, and Philippe et al. (US 2002/0064539) for the reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant does not traverse this ground of rejection in the response filed on 12/1/2009. The ground of rejection is maintained. Terminal disclaimer should be timely filed.

Claims 95-101 and 103-216 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 8-9 and 12-140 of copending Application No. 10/949,448 in view of Marotta et al. (US

6,905,696), HCAPLUS abstract 1964:70247, Flick, and Philippe et al. (US 2002/0064539) for the reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant does not traverse this ground of rejection in the response filed on 12/1/2009. The ground of rejection is maintained. Terminal disclaimer should be timely filed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to John Pak whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Pak/
Primary Examiner, Art Unit 1616